

REMARKS

Applicant respectfully requests reconsideration of this application as amended.

Claims 1, 14 and 16-30 are pending in this application.

Claims 1, 5, 7-9, 13-15, 18, 20-22 and 25 were rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Application Publication 2003/0046421 of a patent application filed by Horvitz et al (hereinafter referred to as "Horvitz").

Claims 3, 6 and 26-30 were rejected under 35 U.S.C. §103(a) as being considered unpatentable over Horvitz in view of U.S. Patent No. 6,532,489 issued to Merchant (hereinafter referred to as "Merchant").

Claims 4, 10-11, 17 and 23 were rejected under 35 U.S.C. §103(a) as being considered unpatentable over Horvitz in view of U.S. Patent No. 5,128,981 issued to Tsukamoto et al (hereinafter referred to as "Tsukamoto").

Claims 6 and 19 were rejected under 35 U.S.C. §103(a) as being considered unpatentable over Horvitz, and it appears that claims 12 and 24 were also rejected under 35 U.S.C. §103(a) as being considered unpatentable over Horvitz.

Claims 2 and 15 have been cancelled.

Claims 1, 7-10, 12, 14, 20-24 and 26 have been amended.

Claims 3 and 32 have been added to more particularly point out and distinctly claim that which Applicant regards as the invention. No new matter has been added.

35 U.S.C. §102(e) Rejection of Claims 1-2, 5, 7-9, 13-15, 18, 20-22 and 25

The Examiner has rejected claims 1-2, 5, 7-9, 13-15, 18, 20-22 and 25 under 35 U.S.C. §102(e) as being considered to be anticipated by Horvitz. Applicant has cancelled claims 2 and 5, thereby obviating this rejection of these claims.

However, Applicant respectfully submits that claims 1, 5, 7-9, 13-14, 18, 20-22 and 25 are not anticipated by Horvitz, because Horvitz does not teach each and every element of Applicant's invention as claimed.

Regarding claims 1 and 14, Horvitz discloses contacting a sender of a message or forwarding a message to a specified email address if an attempt to forward a message by the sender to a user has been unsuccessful under various conditions to inform the sender that the sender's message has not been received, yet. However, Horvitz does not disclose making any selection of either a first or second person to contact, either of which may be the user or may be a person designated by the user as someone permitted to take action in response to the event on behalf of the user. A reading of Horvitz reveals that Horvitz recites always forwarding a message by a sender to the user, first. For at least these reasons, Applicant respectfully submits that claims 1 and 14 are patentably distinguished over Horvitz.

Regarding claims 5, 7, 18 and 20, despite the assertion in the Office Action that Horvitz discloses "determining appropriate and/or desirable actions should be or how to carry on without contact the designator, e.g., other people can be designated by a user to take actions," Applicant can find no disclosure within Horvitz of the designation by a user of any other person to take action on behalf of the user, nor can Applicant find any disclosure of action being taken on behalf of a user, whether by a person designated by the user, or by someone else. Horvitz discloses only making an effort to forward a message to a user, or if unsuccessful, then either forwarding the message to a specified email address or

contacting the sender of the message to inform the sender that the user has not yet received the sender's message. Furthermore, claims 5 & 7, and 18 & 20 depend from independent claims 1 and 14, respectively, which Applicant has previously asserted are patentably distinguished over Horvitz. For at least these reasons, Applicant respectfully submits that claims 5, 7, 18 and 20 are patentably distinguished over any combination of Horvitz and Merchant.

Regarding claims 8-9 and 21-22, these claims depend from independent claims 1 and 14, respectively, which Applicant has previously asserted are patentably distinguished over Horvitz.

Regarding claims 13 and 25, these claims depend from independent claims 1 and 14, respectively, which Applicant has previously asserted are patentably distinguished over Horvitz.

In view of the foregoing arguments, Applicant respectfully asserts that claims 1-2, 5, 7-9, 13-15, 18, 20-22 and 25 are in condition for allowance.

#### 35 U.S.C. § 103(a) Rejection of Claims 3, 16 and 26-30

The Examiner has rejected claims 3, 16 and 26-30 under 35 U.S.C. § 103(a) as being unpatentable over Horvitz, as applied to claim 1, and further in view of Merchant.

Regarding claims 3 and 16, these claims depend from independent claims 1 and 14, respectively, which Applicant has previously asserted are patentably distinguished over Horvitz.

Regarding claim 26, to establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). (MPEP 2143.03). Applicant respectfully submits that neither Horvitz and Merchant, either together or separately, teach or suggest all the features of Applicant's invention.

as recited in claim 26. Claim 26 recites selecting a first person, who may not be the user, to contact in response to an event, using at least one preference and at least one rule in determining how to contact the first person, and then doing so. Both Horvitz and Merchant teach making some effort to contact the user, first, in response to the receipt of a message. Neither Horvitz (as previously discussed) or Merchant teach or suggest selecting a first person who may not be the user to be contacted concerning an event. Neither Horvitz or Merchant teach or suggest referring to preferences, rules or other types of guidelines in determining how to contact someone other than the user. For at least these reasons, Applicant respectfully submits that claim 26 is patentably distinguished over any combination of Horvitz and Merchant.

Regarding claim 27, again, to establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). (MPEP 2143.03). As previously discussed, neither Horvitz nor Merchant teach or suggest making any selection of a first person designated by a user take action in response to an event on behalf of the user, regardless of whether the selection of the first person is restricted to the group recited by claim 27, or not. Also, claim 27 depends from independent claim 26, which Applicant has previously asserted is patentably distinguished over any combination of Horvitz and Merchant. For at least these reasons, Applicant respectfully submits that claim 27 is patentably distinguished over any combination of Horvitz and Merchant.

Regarding claims 28-30, these claims depend from independent claim 26, which Applicant has previously asserted are patentably distinguished over any combination of Horvitz and Merchant.

In view of the foregoing arguments, Applicant respectfully asserts that claims 3, 16 and 26-30 are in condition for allowance.

35 U.S.C. § 103(a) Rejection of Claim 4, 10-11, 17 and 23

The Examiner has rejected claims 4, 10-11, 17 and 23 under 35 U.S.C. § 103(a) as being considered to be unpatentable over Horvitz as applied to claim 1, and further in view of Tsukamoto.

Regarding claims 4, 10, 17 and 23, Applicant respectfully submits that there is no teaching or suggestion to combine Horvitz and Tsukamoto in any way. As previously discussed, Horvitz teaches forwarding a message received from a sender to a user, and if unsuccessful, then either forwarding the message to a specified email address or contacting the sender to notify the sender that the message has not yet been received. Tsukamoto teaches resolving conflicts in schedules between individuals by comparing the relative importance of each individual's meetings where conflicts in schedules arise. Horvitz does not teach or suggest resolving schedule conflicts in any way, and Tsukamoto does not teach or suggest selecting ways to forward a message. For at least these reasons, Applicant respectfully submits that claims 4, 10, 17 and 23 are patentably distinguished over any combination of Horvitz and Tsukamoto.

Regarding claim 11, this claim depends from claim 10 which Applicant has previously asserted are patentably distinguished over any combination of Horvitz and Tsukamoto. The previously discussed deficiencies in what any combination Horvitz and Tsukamoto teach and suggest is not cured as a basis for a rejection of claim 11 by a possible teaching or suggestion of Horvitz of a user being allowed to exclude a message to be delivered. For at least these reasons, Applicant respectfully submits that claim 11 is patentably distinguished over any combination of Horvitz and Tsukamoto.

In view of the foregoing arguments, Applicant respectfully asserts that claims 4, 10-11, 17 and 23 are in condition for allowance.

35 U.S.C. § 103(a) Rejection of Claim 6, 12, 19 and 24

The Examiner has rejected claims 6 and 19 under 35 U.S.C. § 103(a) as being considered to be unpatentable over Horvitz, alone. It also appears, and Applicant makes the presumption, that the Examiner also rejected claims 12 and 24 under 35 U.S.C. § 103(a) as being considered to be unpatentable over Horvitz, alone, although this is not precisely stated in the Office Action.

Regarding claims 6 and 19, as previously discussed, the Office Action acknowledges that there is no explicit teaching or suggestion of "a rule that prohibit other person to take action without contact designator," and Applicant respectfully submits that this is simply consistent with Horvitz in no way teaching or suggesting any designation by a user of any other person to take action on behalf of the user, nor does Horvitz disclose any action being taken on behalf of a user, whether by a person designated by the user, or by someone else, as previously discussed. As also previously discussed, Horvitz teaches only making an effort to forward a message to a user, or if unsuccessful, then either forwarding the message to a specified email address or contacting the sender of the message to inform the sender that the user has not yet received the sender's message. Also, claims 6 and 19 depend from independent claims 1 and 14, respectively, which Applicant has previously asserted are patentably distinguished over Horvitz. For at least these reasons, Applicant respectfully submits that claims 6 and 19 are patentably distinguished over Horvitz.

Regarding claims 12 and 24, to establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). (MPEP 2143.03). As previously discussed Horvitz does not teach or suggest making any selection of a first person designated by a user take action in response to an event on behalf of the user, regardless of whether the selection of the first person is

restricted to the group recited by claim 12 or 24, or not. Also, claims 12 and 24 depend from independent claims 1 and 14, respectively, which Applicant has previously asserted are patentably distinguished over Horvitz. For at least these reasons, Applicant respectfully submits that claims 12 and 24 are patentably distinguished over Horvitz.

In view of the foregoing arguments, Applicant respectfully asserts that claims 6, 12, 19 and 24 are in condition for allowance.

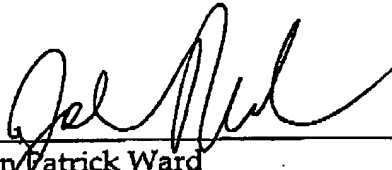
Condition for Allowance

Applicant submits that all rejections have been overcome and the present application is now in condition for allowance. If there are any additional charges or shortages related to the present communication, please charge our Deposit Account No. 02-2666.

Respectfully submitted,

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Dated: September 30, 2003

  
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